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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/820,496 03/19/97 WILHELM

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MMC2/0912

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EXAMINER

FLEMING, F

ART UNIT

PAPER NUMBER

2836

DATE MAILED:

09/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.
08/820,496

Applicant(s)
Wilhelm

Examiner
Fritz M. Fleming

Group Art Unit
2836



☒ Responsive to communication(s) filed on Jul 5, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-4, 9, 10, 16, 19, 22-31, and 34-114 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4, 9, 10, 16, 19, 22-31, and 34-114 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152


FRITZ FLEMING
PRIMARY EXAMINER
GROUP 2100

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. Per MPEP 201.08, this instant application cannot be accorded status as a continuation in part of 08/606,219 (now 5,786,642), and hence cannot be then a CIP of 08/328,574, as the instant application did not "..., repeating some substantial portion or all of the earlier nonprovisional application and adding matter not disclosed in the said earlier nonprovisional application." Applicant did not incorporate by reference or repeat anything substantial from any of the alleged parent cases. A mere listing of alleged continuity does not satisfy the requirements of a CIP. None of the drawings are common, nor are any of the sections of the written disclosure (from instant to alleged parent application). As such is the case, this clouds the efficacy of the 1.131 declaration filed 4-28-98 as on its face, this application is not a proper CIP and not entitled to the subject matter of the filing date of the alleged parent cases.

In the response, applicant has not specifically pointed to the specific and actual "incorporation by reference" which would entitle applicant to a CIP status. Failing to show such simply results in maintaining the above.

2. The amendment to page 4, line 25 filed 4-28-98 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Per the above, this application is not entitled the subject matter of the alleged parent cases and hence addition of such constitutes new matter. Also the response(s) with the numerous versions of substitute specifications (3 as best can be determined) are deemed to be "new matter" as per the above, the filing of this was an incorrect CIP and now to add the material that was never properly incorporated by reference is the addition of new matter.

Applicant is required to cancel the new matter in the reply to this Office action.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-4,9,10,16,19,22-31,34-114 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As noted above, the amendment(s) above is/are clearly new matter and claims directed to such are also new matter. It is unclear what is to be construed by a "universal power system" as such is not explained in the context of the instant application. Comments alleging "no new matter" are not understood as it is entirely unclear how any of the instant drawings can invoke properties from two different patents when the alleged

CIP does not even bother to explain how two different figures from two different patents can combine in a previously undisclosed manner in this application. If the instant application were a true CIP, it would have clearly repeated substantial portions of the previous alleged parent applications and provided the CIP material in conjunction with the substantial portions of the alleged parent applications in some sort of new arrangement of the alleged parent cases and shown and described in this application. Merely alleging such after the fact is clearly an indication of new matter. Per the above, applicant is limited what was encompassed by the four corners of the originally filed application as of 3/19/97 and any additional material is construed to be new matter. Mere post filing picking and choosing and combining undisclosed features from alleged parent applications does not overcome this new matter rejection. The submission of 3 substitute specifications does not cure the underlying defect of never having incorporated by reference the previous material.

5. Claims 1-4,9,10,16,19,22-31,34-114 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Per the above, applicant is entitled to what was originally filed on 3/19/97 and not any material from alleged parent cases. Enablement is clearly lacking, even if the previous applications were somehow properly incorporated, because the instant alleged CIP makes absolutely no attempt to bring together any substantial portions of the alleged parent cases with what is presently disclosed in any sort of enabling manner for what is claimed. Enablement for

anything of anymore detail than provided in the scant material disclosed by the Figures and 4 pages of disclosed detailed description. How do 4 pages of disclosure and the supplied Figures enable the undue multiplicity of almost 100 claims that somehow in some undisclosed manner appear to arbitrarily pick and choose material from the alleged parent cases? The connection that should be present in the CIP is simply not there and there is a glaring lack of enablement for what is presently claimed. For example, there is disclosed a single control means that somehow, absent any details whatsoever, is capable of performing all of the claimed functions. How is this possible as Figure 10 does not even bother to give such a reference numeral? The discussions of Figures 10 and 11 occupy less than 50 lines and do not even mention the claimed attributes of the control means and related control circuits. How can this control means perform all of the wonderful functions when it is only connected to the voltage regulator means or a DC power converter? How are power sharing/proportioning/combining/leveling and all of the other functions carried out per the scant disclosure? Where is the switch over during failure, the inverter, all of the secondary connections, the multiple alternative types, the brown out, the excursions, unitary and modular building block packages, close physical proximity, managing of end user service power, multiple power control circuits of the power controller with associated functions, greater than a predetermined capacity, fractional portions, proportionate change, supporting cabling, limiting upon loading, the power controller connections, high efficiency (a relative term needs some sort of quantification), PV control via the power control means, reduction of power taken from the grid, the three modes, control of recharging via the power controller. Applicant is respectfully requested to provide an indication of enablement for each and every claimed feature and combination as it is evident from the above that such are missing, by referring to where such can be found within the confines of the four corners of the instant

application. Mere post filing picking and choosing and combining undisclosed features from alleged parent applications does not overcome this enablement rejection. See especially MPEP 2164.06(a)I. Applicant has claimed a very complicated and involved system without requisite level of disclosure resulting in a clear lack of enablement. This is further compounded by the objects of the invention and summary of the invention spanning about 2.5 pages wherein the detailed description only covers 4 pages and does not enable the previously mentioned objects/summary.

The numerous responses do not provide the above in order to assist in any sort of determination of “new matter” or “enablement” as the 3 responses have apparently added 5 Figures and 20 pages of descriptive material without pointing to where the numerous claims enjoy the above.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Per the above, it is unclear what the metes and bounds of the claimed subject matter is intended to be. The claims are also replete with antecedent basis problems, such as the use of “such as” of claim 49, claim 49 setting forth a plurality of primary sources in the alternative and then referring back to such in the singular, the inclusion of “such as” in claim 1. It is applicant’s responsibility to submit claims that comply with 35 USC 112 in order to expedite prosecution of the application.

Applicant has failed to attempt to correct the above as it appears as though no changes to the claims were made in any of the 3 substitute specifications.

Accordingly, considerable speculation would be required on the part of the examiner in order to attempt to discern the metes and bounds of the claimed subject matter when attempting to interpret such in light of the specification.

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, each and every claimed feature, combination and function must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

It is clearly evident from the 11 Figures that all of the claimed subject matter is not shown.

9. Due to the above, it is improper to apply any sort of art rejection(s) at this time as to do so would improperly rely upon considerable speculation on the part of the examiner. See MPEP 2173.06 In re Steele.

10. Applicant's arguments filed on numerous previous dates have been fully considered but they are not persuasive.

First of all it is unclear if the last substitute spec is to take the place of or be in addition to the 2 previous substitute specs as the final version does not repeat any of the arguments. Hence it is unclear if the arguments are to transfer to the latest version.

The examiner did address the previously allowed claims in that they were rejected per the body of the rejection(s).

Please also note that a new examiner is assigned this application so as to properly address future correspondence.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fritz Fleming whose telephone number is (703) 308.1483.


FRITZ FLEMING
PRIMARY EXAMINER
GROUP 2100

fleming

September 8, 2000